

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/661,159

Confirmation No.: 6784

Applicant(s): Vargas

Filing Date: 12 September 2003

Title: "Shape-Transferring Cannula System  
and Method of Use"

TC/Art Unit: 3736

TC Examiner: Hoekstra, J.

Petitions Examiner: Johnson, N.

Docket No.: ENDOV-001/US

**Supplemental Petition**

Date: 15 June 2010

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Via Electronic Filing System**

Sir:

Office of Petitions Examiner Nancy Johnson has asked that Applicant submit a supplemental petition to make portions of the petition filed 24 March 2010 more legible. Accordingly, Applicant submits this supplemental petition that includes (a) the originally filed petition text and Exhibit 1, and (b) portions originally filed as Exhibit 1 enlarged to enhance readability.

Applicant respectfully requests that this petition be granted, that the above-referenced application be revived, and that prosecution be continued in accordance with the papers filed on 24 March 2010.

**Text from the originally filed petition.**

Applicant respectfully petitions to withdraw a holding of abandonment, because Applicant failed to receive a Notice of Non-Compliant Amendment.

I.

The United States Patent and Trademark Office (the "Office") allegedly mailed a Notice of Non-Compliant Amendment (the "Notice") for this application on 17 November 2009. It appears that this Notice was mailed in response to Applicant's amendment document filed on 7 October 2009. As the Notice appears in the Patent Information and Retrieval System, the Notice states that the amendment document was non-compliant because the claim status identifier "Amended" should instead be "Currently Amended".

II.

In accordance with the information outlined in the Manual of Patent Examining Procedure (8th Ed. Rev. Jul. 2008), § 711.03(c), Applicant provides the following statements and information.

A. The system used to record Office actions at Intuitive Surgical, Inc. begins with the receipt of all mail addressed to the correspondence address of record associated with this application being delivered to a central mail room. There, the mail is sorted by recipient address within the company. Mail from the Office is placed in a mail receptacle for the legal department. At least once each day, a clerk in the legal department retrieves the mail from this receptacle.

Mail from the Office is first opened and examined by employee Anne Killingsworth, who functions as the legal department's docketing clerk. If a paper from the Office indicates that a response is required by a particular deadline, Anne does two things. First, she retrieves the paper file associated with the particular application and clips the paper to the outside of the file. Second, she enters the due date in the legal department's computerized docketing system record associated with the particular application. For situations that require a response be filed within one month of the paper's mailing date, Anne's general practice is to call one of the legal department's patent attorney's immediate attention to the paper. Anne prepares action due lists for all deadlines entered into the legal department's computerized docketing system, and she provides these lists to the appropriate legal department attorney.

B. The legal department uses the computerized Dennemeyer Intellectual Asset Management System (DIAMS) version 8.04.09.4, provided by Dennemeyer & Co., to record due dates associated with papers received from the Office. This is a reliable system. Entry data for each patent application includes the Office's application number, the corresponding attorney docket number, and the due date for any response required by a paper received from the Office.

C. To the best of the undersigned attorney's information and belief, the Notice was not received at Intuitive Surgical, Inc. The undersigned attorney has searched the legal department mail receptacle in the mail room and the surrounding area (e.g., under the receptacle shelves in case the Notice had somehow fallen), the shelf area in which the paper record associated with this application is kept, and the contents the paper record associated with this application but was unable to find the Notice.

D. To the best of the undersigned attorney's information and belief, the legal department first learned that the Notice had been mailed when the legal department received a Notice of

Abandonment that the Office appears to have mailed on 19 February 2010. Upon receipt of this Notice of Abandonment, Anne Killingsworth accessed the Office's Patent Application Information Retrieval system and was able to download a copy of the Notice of Non-Compliant Amendment.

E. To the best of the undersigned attorney's information and belief, the docketing system does not provide a "master docket for the firm" for a particular date range in any usable form. In lieu of such a "master docket", attached to this Petition as Exhibit 1 are (i) an image of the portion of the docketing system record that is associated with this application's identifying details, and (ii) two images that show the portion of the docketing system record that is associated with this application's due dates (completed and pending). These images indicate that the due date associated with the Notice was not entered into the legal department's docketing system, and they are submitted as further evidence that the Notice was not received. The images show that some portion of the record associated with this application was updated on 24 November 2009, but again, there is no evidence that any due date associated with the Notice was entered. After discussing this matter with Anne Killingsworth, the undersigned attorney was unable to determine what portion, if any, of this record was updated on 24 November 2009.

### III.

Applicant respectfully petitions the Director under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment. Accordingly, Applicant believes that no petition fee is due.

If, however, the Office determines that this Petition is more correctly made under 37 C.F.R. § 1.137(a) or 1.137(b), then to speed handling of this Petition the Office is authorized to deduct from Deposit Account No. 503404 \$540.00 (for § 1.137(a)) or \$1620.00 (for § 1.137(b)) as may be necessary.

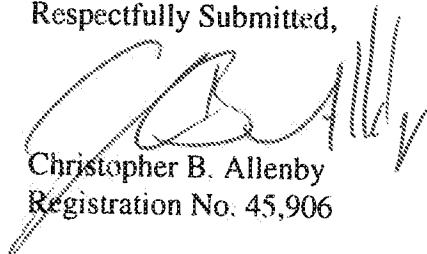
In addition, the Office is authorized to deduct from Deposit Account No. 503404 any additional fees that may be due to reopen prosecution of this application. Large entity fees apply.

IV.

Applicant includes with this Petition a corrected version of the amendment paper filed 7 October 2009. This corrected version includes the correct claim status identifiers for all claims.

Applicant respectfully requests the Director grant this petition. Please contact the undersigned attorney at 408-523-2460 if there are any questions.

Respectfully Submitted,



Christopher B. Allenby  
Registration No. 45,906

Exhibit 1

Docket System Images

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

DIAMS

File Main Menu Reports Utilities Research Windows Help

DIAMS - Patent Management (View only)

Docket ID: ENDOV001/US Short Title: CAMERA SYSTEM & METHOD OF USE

Client/Business Units: Applicant/Patentees: Other Party: ☐

Attorneys: Cost Centers:

Related Matters: Inventors: Laboratories:

ALLENBY CHRISTOPHER

VARGAS JAIME S

Invention Disclosure Disclosure 2 Prior Art Names Patent Details Additional Info Docs Link Docketing

Country: Convention: Type: Application No: Application Date:

Region: Origin: Sub Type: Grant No: Grant Date:

Status: Pending Independent Claims: Request Search Date: 1st Publication No: 1st Publication Date:

Sub Status: Published Dep. Multi Dep. Request Exam. Date: 2nd Publication No: 2nd Publication Date:

Claimed Priorities & Parent Records

Priority	Parent	Child	Child No.	Child Date
Priority	ENDO001PROV/US	12-Sep-2002	1	12-Sep-2002

File Status: Abandoned Date: Expiration Date:

File Ref: Last Annuity Paid: Next Annuity Due:

Annuity Instructions: ☐ Calculate Depreciation & Amortization

Record 4 of 1 Created: 13-Sep-2007 Updated: 14-Sep-2007

Ready NUM

This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

The screenshot shows the DIAMS Patent Management (View only) window. The top menu bar includes File, Main Menu, Reports, Utilities, Research, Windows, and Help. The window title is "DIAMS - Patent Management (View only)".

The main form contains the following fields:

- Docket ID: ENDOV001/US
- Short Title: CANALLA SYSTEM & METHOD OF USE
- Client/Business Units: [Empty]
- Applicant/Patentees: [Empty]
- Attorneys: ALLENBY CHRISTOPHER
- Cost Centers: [Empty]
- Inventors: VARGAS JAIME S
- Laboratories: [Empty]
- Related Matters: [Empty]
- Other Party: [Empty]

Below the form is a tabbed interface with the following tabs: Invention, Disclosures, Disclosure 2, Prior Art, Names, Patent Details, Additional Info., Docs Link, and Docketing. The "Docketing" tab is selected.

The Docketing tab displays a table of docket entries. The table has columns for Phase, Subphase, From, and To. The entries are as follows:

Phase	Subphase	From	To
Application Date		10/661159	12-Sep-2003
Publ. First		2004-005432	18-Mar-2004
QA1 Mail Date			20-Oct-2008
Final QA Mail Date			15-Nov-2007
ADVISOR OPTION			15-Nov-2007
Abandoned Date			15-Nov-2007
Restriction Requirement Mail Date			15-Nov-2007
IDS VERT & ATTY			04-Nov-2008
ids atty			17-Nov-2008
ext			17-Dec-2008
QA2 Mail Date			05-Dec-2008
Expiration Date			09-Apr-2009
QA1 Response Due			15-Nov-2007
Final Resp. Due - 2 Mo Delay			15-Nov-2007

At the bottom of the window, the status bar shows "Record 1", "Created 15-Nov-2007", "Updated 24-Nov-2009", and "Ready".

This is the second of two pages that show docket entries (due and completed) currently in the DIAMS system that are associated with this application.

**DIAMS**

File Menu Reports Utilities Research Windows Help

**DIAMS Patent Management (View only)**

Docket ID: ENDOV001/LIS Short Title: CANNULA SYSTEM & METHOD OF USE

Client/Business Units: \_\_\_\_\_ Applicant/Patentees: \_\_\_\_\_ Other Party: ☐

Attorneys: ALLENBY CHRISTOPHER Cost Centers: \_\_\_\_\_

Related Matters: \_\_\_\_\_ Inventors: VARGAS JAIME S Laboratories: \_\_\_\_\_

Invention Disclosure Disclosure 2 Prior Art Names Patent Details Additional Info Docs Link Docketing

Phase: ☐ NYF ☐ Pending ☐ Grant ☒ All ☒ Events ☒ To Do ☒ Done Subphase: 3 From: \_\_\_\_\_ To: \_\_\_\_\_

Event	Due Date	Subphase	From	To
Ext	29-Dec-2008			05-Dec-2008
OA2 Mail Date	07-Apr-2009			09-Apr-2009
Expiration Date	12-Sep-2023			15-Nov-2007
OA1 Response Due	17-May-2006	13-Aug-2006	42491	15-Nov-2007
Final Resp. Due - 2 Mo Rem	01-Dec-2006			15-Nov-2007
Final Resp. Due - 1 Mo Rem	01-Jan-2007			15-Nov-2007
Response to Provoked Advisory Action	01-Jan-2007	30-Jan-2007	42491	15-Nov-2007
Final Response Due	01-Feb-2007			15-Nov-2007
Final Resp. Due - 1 Mo Ext	01-Mar-2007			15-Nov-2007
Final Resp. Due - 2 Mo Ext	01-Apr-2007			15-Nov-2007
Final Resp. Not. of Appeal Due - FINAL	01-May-2007			15-Nov-2007
Restriction Requirement Resp. Due	29-Nov-2008	12-Nov-2008	42491	04-Nov-2008
OA2 Response Due	07-Jul-2009	07-Oct-2009	42491	09-Apr-2009

Record 4 2/5 Created 15-Nov-2007 ANNEX Updated 15-Nov-2007 ANNEX 22-Nov-2010

Ready ALM

\*\*\*\*\* Last Item \*\*\*\*\*



Supplement to Exhibit 1

This supplement enlarges the docket system images in the petition filed 24 March 2010.

Applicant believes these enlarged images are legible and suitable for consideration.

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

The screenshot displays the DIAMS Patent Management Overview interface. The top menu bar includes File, Main Menu, Reports, Utilities, Research, Windows, and Help. The main content area is divided into several sections:

- Docket ID:** ENDV001/JUS
- Short Title:** CANINULA SYSTEM & METHOD OF USE
- Client/Business Units:** [Empty]
- Attorneys:** ALLENBY CHRISTOPHER
- Inventors:** VARGAS, JAIME S
- Related Matters:** [Empty]
- Applicant/Patentees:** [Empty]
- Cost Centers:** [Empty]
- Laboratories:** [Empty]
- Other Party:** [Empty]

The **Patent Details** section includes the following information:

- Country:** United States of America
- Convention:** Pti. Claimed
- Type:** Patent
- Application No:** 10/661159
- Application Date:** 12-Sep-2003
- Grant No:** [Empty]
- Grant Date:** [Empty]
- Region:** [Empty]
- Sub Type:** [Empty]
- 1st Publication No:** 2004-0054322
- 1st Publication Date:** 18-Mar-2004
- 2nd Publication No:** [Empty]
- 2nd Publication Date:** [Empty]
- Status:** Pending
- Sub Status:** Published
- Request Search Date:** [Empty]
- Request Exam. Date:** [Empty]
- File Status:** Abandoned Date 06-Aug-2007
- File Ref:** [Empty]
- Annulity Instructions:** [Empty]
- Annulity Due:** [Empty]

The **Claimed Priorities & Parent Records** section shows:

- Priority:** ENDV001PROV/JUS 12-Sep-2002
- Parent:** [Empty]

The bottom status bar indicates: Record 4, 45, Created 05-Nov-2007, AmEx, Updated 24-Nov-2009, AMEX, 22-Mar-2010, and Ready.

This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

**DIAMS**  
 File Main Menu Reports Utilities Research Windows Help

**DIAMS - Patent Management (View Only)**

Docket ID: END0001/US Short Title: CANALIA SYSTEM & METHOD OF USE

Client/Business Units:

Applicant/Patentees:

Other Party: ☐

Attorneys:

Cost Centers:

Inventors: ALLENBY CHRISTOPHER

Laboratories:

Related Matters:

Inventors: VARGAS JAIME S

Phase: ☐ NYF ☐ Pending ☐ Grant ☐ All

Events: ☒ To Do ☒ Done

Subphase:

From:

To:

Phase	Event	Date	From	To
Application Date	10/661159	12-Sep-2003		15-Nov-2007
Public First	2004-005432	18-Mar-2004		20-Oct-2008
OA1 Mail Date		17-Feb-2006		15-Nov-2007
Final OA Mail Date		01-Nov-2006		15-Nov-2007
ADVISOR OPINION		21-Feb-2007		15-Nov-2007
Abandoned Date		06-Aug-2007		15-Nov-2007
Restriction Requirement Mail Date		29-Oct-2008		04-Nov-2008
IDS VERT & ATTY		12-Nov-2008		17-Nov-2008
ids atty		12-Dec-2008		17-Dec-2008
ext		29-Dec-2008		05-Dec-2008
OA2 Mail Date		07-Apr-2009		09-Apr-2009
Expiration Date		12-Sep-2023		15-Nov-2007
OA1 Response Due		17-May-2006	82491	15-Nov-2007
Final Resp. Due - 2 Mo Rem		01-Dec-2006		15-Nov-2007

Record: 1/1 Created: 15-Nov-2007 AM 02:00 Updated: 24-Nov-2009 AM 09:00

Ready

This is the second of two pages that show docket entries (due and completed) currently in the DIAMS system that are associated with this application.

**DIAMS**  
 File Main Menu Reports Utilities Research Windows Help

**DIAMS - Patent Management (View only)**

Docket ID: **ENDOW001/US** Short Title: **CANALJA SYSTEM & METHOD OF USE** Other Party: ☐

Client/Business Units: **Applicant/Patentees**

Attorneys: **ALLENBY CHRISTOPHER** Cost Centers: **Laboratories**

Inventors: **VARGAS JAIME S**

Related Matters: **Patent Details**

Invention Disclosure 2 Prior Art Names Patent Details Additional Info Docs Link Docketing

Phase: ☐ NYP ☐ Pending ☐ Grant ☐ All ☒ Events ☒ To Do ☒ Done

Subphase: **29-Dec-2008** From: **05-Dec-2008** To: **05-Dec-2008**

Event	Due Date	From	To
CA2 Mail Date	07-Apr-2009	09-Apr-2009	09-Apr-2009
Expiration Date	12-Sep-2023	15-Nov-2007	15-Nov-2007
CA1 Response Due	17-May-2006	13-Aug-2006	42491
Final Resp. Due - 2 Mo Rem	01-Dec-2006	15-Nov-2007	15-Nov-2007
Final Resp. Due - 1 Mo Rem	01-Jan-2007	15-Nov-2007	15-Nov-2007
Response to Provide Advisory Action	01-Jan-2007	30-Jan-2007	42491
Final Response Due	01-Feb-2007	15-Nov-2007	15-Nov-2007
Final Resp. Due - 1 Mo Ext	01-Mar-2007	15-Nov-2007	15-Nov-2007
Final Resp. Due - 2 Mo Ext	01-Apr-2007	15-Nov-2007	15-Nov-2007
Final Resp. Meet. of Appeal Due - FINAL	01-May-2007	15-Nov-2007	15-Nov-2007
Restriction Requirement Resp. Due	29-Nov-2006	12-Nov-2008	42491
CA2 Response Due	07-Jul-2009	07-Oct-2009	42491

Record 6 of 25 Created: 15-Nov-2007 16:00:00 Updated: 29-Nov-2009 16:00:00

Ready